

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

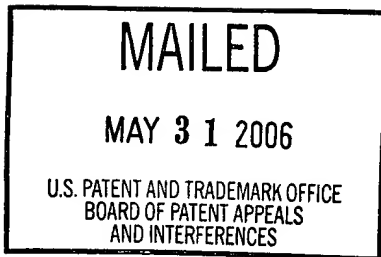
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BARNEY J. AUMAN

Appeal No. 2006-0593
Application No. 09/895,611

ON BRIEF



Before FRANKFORT, OWENS and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 3, 4, 6 and 7,
the only claims pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a machine used to rotate the mold of a capital for an architectural column in the process of manufacturing a capital from elastomers and foams or elastomer-foam combinations (present specification, page 1).

A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Independent claims 3 and 6 are illustrative of appellant's invention and read as follows.

3. A machine for manufacturing a capital for an architectural column, which comprises:

- a shaft;
- a means for rotating said shaft about a first axis, wherein said shaft extends substantially symmetrically about a point of rotation for the first axis;
- a means for rotating said shaft about a second axis that is substantially orthogonal to said first axis;
- a means for rotating said shaft about a third axis that is substantially orthogonal both to the first axis and to the second axis; and
- a releasable connector attached to said shaft for connecting a mold to said shaft.

6. A machine for manufacturing a capital for an architectural column, which comprises:

- a shaft;
- a means for rotating said shaft about a first axis;
- a means for rotating said shaft about a second axis that is substantially orthogonal to said first axis;
- a means for rotating said shaft about a third axis that is substantially orthogonal both to the first axis and to the second axis; and
- a releasable connector attached to said shaft for connecting a mold to said shaft.

Applied Prior Art

Mankowich et al. (Mankowich)	3,347,971	Oct. 17, 1967
Bavers	3,596,324	Aug. 3, 1971
Von der Heide	3,683,062	Aug. 8, 1972
Pivar	3,825,395	Jul. 23, 1974
Friesen	4,695,244	Sep. 22, 1987
Pitavy et al. (Pitavy)	4,764,322	Aug. 16, 1988
Lin	5,035,601	Jul. 30, 1991

The Rejections

Claims 3, 4, 6 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by von der Heide.

Claims 3, 4, 6 and 7 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pitavy in view of any one of Pivar, Lin, Bavers, Friesen, Mankowich and von der Heide.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer (mailed June 1, 2005) for the examiner's complete reasoning in support of the rejections and to the appellant's brief (filed March 7, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. On the basis of this review, for the following reasons, we conclude that the examiner's rejections should be sustained.

The teachings of the references relied upon by the examiner are not in dispute in this appeal. Rather, the dispositive issue in this appeal is the meaning of "a means for rotating said shaft about a third axis that is **substantially orthogonal both to the first axis and to the second axis**" as set forth in independent claims 3 and 6. Specifically, the appellant contends that von der Heide does not anticipate the subject matter of claims 3, 4, 6 and 7 because

although the axes of the device in von der Heide that produce rotation in the direction of the arrows 110 and 111 will always be orthogonal to one another, the axis that produces the rotation shown in FIG. 9 in a clockwise direction, will not always be orthogonal to the axis that produces the rotation in the direction of arrow 110. In fact, rotation in the direction of arrow 111 will sometimes cause the axis that produces the rotation in the direction of arrow 110 to be parallel to the axis that produces the rotation shown in FIG. 9 in a clockwise direction [brief, page 12].

Likewise, with respect to Pitavy, the appellant urges that

in Pitavy et al., although the y and z axes will always be orthogonal to one another and the x and y axes will always be orthogonal to one another, rotation about the y axis will

cause the x axis not to be orthogonal with respect to the z axis and, at times, even parallel to the z.

Consequently, Applicant respectfully suggests that no matter with what Pitavy et al. is combined, the combination will not create the device of the present claims 3, 4, 6, and 7, which require a third axis that is substantially orthogonal both to the first axis and to the second axis [brief, page 13].

We find no requirement in any of claims 3, 4, 6 and 7 that the first, second and third axes be orthogonal, or even substantially orthogonal to one another at all times.

Moreover, we find no indication in the appellant's underlying disclosure, either with the specification as originally filed or as amended with the subject matter objected to by the examiner as new matter, that the third axis of rotation is substantially orthogonal to both of the first (pitch) and second (roll) axes of rotation at all times during the rotation.

Specifically, with the table 19 rotated substantially away from its orthogonal orientation, shown in Figure 2, with respect to the supporting bars 20, the (roll) axis of rotation of shaft 2 will not be substantially orthogonal to the axis of rotation of the supporting bars 20 (as described in the penultimate paragraph on page 8 of appellant's specification as originally filed). On the other hand, even with the description of the third axis of rotation in the amended version of the penultimate paragraph on page 8 of the specification, rotary motion of supports holding the shaft 2 to table 19 would move the (roll) axis of rotation of the shaft to an orientation that is not substantially orthogonal to the (pitch) axis of the table 19. We thus conclude that the claim language "a means for rotating said shaft about a third axis that is substantially orthogonal both to the first axis and to

the second axis" cannot reasonably be read, in light of appellant's specification, as requiring that the three axes of rotation be substantially orthogonal to one another at all times during the rotation.

In light of the above, the appellant's line of argument is not persuasive of any error on the part of the examiner in determining that claims 3, 4, 6 and 7 are anticipated by von der Heide or rendered unpatentable over Pitavy in view of any of Pivar, Lin, Bavers, Friesen, Mankowich and von der Heide. The rejections are sustained.

The appellant contends that the examiner's objection to the amended specification under 35 U.S.C. § 132 as containing new matter is an appealable issue, presumably on the basis that Section 2163.06 of the Manual of Patent Examining Procedure (MPEP) indicates that "If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition" (brief, page 12). We are not, however, presented with the situation described in that section of the MPEP. Specifically, while it is true that the examiner has both objected to new matter in the specification and rejected claims 3, 4, 6 and 7, the examiner has not rejected the claims as containing new matter (or lacking written description support) and has not alleged that the particular subject matter in the specification characterized by the examiner as new matter is present in any of the claims. In this instance, for the reasons discussed above, the determination with regard to the objection to the

specification has no bearing on the anticipation and obviousness issues in this appeal. Accordingly, the examiner's objection and requirement for deletion of new matter added to the specification is reviewable by petition under 37 CFR § 1.181 and not by the Board of Patent Appeals and Interferences.

CONCLUSION

To summarize, the decision of the examiner to reject claims 3, 4, 6 and 7 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) is AFFIRMED.

AFFIRMED

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

Appeal No. 2006-0593
Application No. 09/895,611

Page 9

FEHR LAW FIRM
Suite 300
Goldenwest Corporate Center
5025 Adams Avenue
Ogden, UT 84403